REMARKS

The present application was filed on January 29, 2004 with claims 1-13.

In the outstanding Office Action dated June 28, 2006, the Examiner: (i) rejected claims 1-13 under 35 U.S.C. §102(a) as being anticipated by the Applicants' Admitted Prior Art (Background of the Invention, pages 1-6) (hereinafter "APA").

Regarding the objection to the drawings, FIGS. 15a, 15b and 15c have been amended to overcome the objection.

With regard to the §102(e) rejection, Applicants initially note that MPEP §2131 specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention . . . in as complete detail as is contained in the . . . claim," citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully traverse the §102(a) rejection on the ground that the Applicants' APA fails to teach or suggest each and every limitation of claims 1-13 as alleged.

Independent claim 1 is directed to a method for generating one or more candidates for a structure pattern pointing to an element or an element set in a structured document. The method comprises the steps of: preparing document logical structure information about the structured document and conditions and indexes for display for giving selection criteria to a user; accepting the structure pattern pointing to an element or an element set in the structured document specified by the user, wherein the structure pattern is comprised of one or more items; determining an item to be edited among the one or more items; generating one or more structure pattern candidates by replacing the item to be edited with items in different expressions based on the document logical structure information; and rearranging the generated one or more structure pattern candidates based on the condition and index for display to generate a structure pattern candidate list.

The Examiner in formulating the §102(e) rejection of claim 1 argues that each and every one of the above-noted limitations of claim 1 is anticipated by the APA. Applicants respectfully disagree.

In characterizing the APA as allegedly meeting certain limitations of claim 1, the Examiner relies primarily on FIG. 15a and pages 2-6 of the present background of the invention. However, the relied-upon portions of the background of the invention fail to anticipate the limitations as alleged.

The Examiner argues that the conditions and indexes for display for giving selection criteria to a user is disclosed on page 6, lines 4-6 of the background of the invention. Page 6, lines 4-8, states: "directories and files below "/home/" are shown as "/home/user1", "home/user2", and so on, with the file paths complemented automatically...[t]he function of complementing a file path, however, complements a file path from the top toward the end, and the user must search all the hierarchies from the hierarchy, which is base point in the path, to the hierarchy where the desired information exists." Nowhere in the referenced passage is there a description relating to, for example, conditions and indexes for display for giving selection criteria to a user.

The Examiner argues that the step of accepting said structure pattern pointing to an element or an element set in said structured document specified by the user, wherein said structure pattern is comprised of one or more items is disclosed on page 5, lines 19-23 of the background of the invention. Page 5, lines 17-25 states the following:

> ...Furthermore, the user is still required to have detailed knowledge about structure patterns in order to know whether or not the automatically created structure pattern has durability.
>
> Depending on the contents of a structured document, it may be possible to predict a part which may be changed in the future to some extent. Thus, if it is possible to specify the part of the structure pattern that is predicted to be changed in the future as an item desired to be edited and complement the part with a durable expression, then a user will be able to quickly obtain only a structure pattern that is suitable for his purpose from many kinds of structure patterns.

However, there is no description in the relied-upon portions of the APA relating to, for example, accepting said structure pattern pointing to an element or an element set in said structured document specified by the user, wherein said structure pattern is comprised of one or more items.

The Examiner argues that the step of determining an item to be edited among the one or more items is disclosed on page 4, line 21 through page 5, line 2 and lines 19-21 of the background of the invention. Page 4, line 20 through page 5, line 2 states the following with emphasis supplied:

> Furthermore, there are many kinds of durable structure patterns, and <u>thus it is difficult to select a structure pattern most suitable for possible future changes made in a document.</u>
>   In spite of the situation described above, <u>there is no editing environment for creating a durable structure pattern provided by the existing technology.</u> There are XSLT editing systems including, for example, "eXcelon Stylus" by eXcelon Corporation, "XML Spy" by Altova Corporation, "IBM XSL Editor" by IBM Corporation, etc. Though these editing environments provide a function of automatically generating an XPath, the generated XPath is <u>limited</u> only to a simple, fixed path searching sequentially from a parent to a child.

Applicants respectfully note that the above referenced passage does not teach or suggest the step of determining an item to be edited among the one or more items. Rather, the above referenced passage refers to the shortcomings in the various prior arts, i.e., "There are many kinds of durable structure patterns, and thus it is difficult to select a structure pattern most suitable... In spite of the situation described above, there is no editing environment for creating a durable structure pattern provided by the existing technology... Though these editing environments provide a function of automatically generating an XPath, the generated XPath is limited..."

In addition, the passage referenced by the Examiner (page 6, lines 15-16), as teaching the step of generating one or more structure pattern candidates by replacing said item to be edited with items in different expressions based on said document logical structure information, also refers to the limits of the prior arts, and the demand for realization of a system by which many kinds of complicated structure patterns are automatically generated.
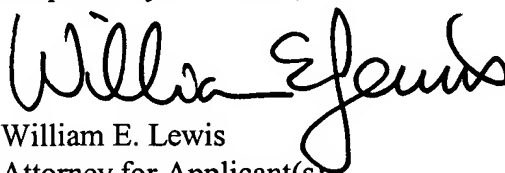
Accordingly, it is believed that the APA fails to meet the limitations of claim 1.

Independent claims 6 and 11-13 include limitations similar to those of claim 1, and are therefore believed allowable for reasons similar to those described above with reference to claim 1.

Attorney Docket No. <u>JP920020228US1</u>

Dependent claims 2-5 and 7-10 are believed allowable for at least the reasons identified above with regard to claim 1. One or more of these claims are also believed to define separately-patentable subject matter over the cited art.

In view of the above, Applicants believe that claims 1-13 are in condition for allowance, and respectfully request withdrawal of the §102(a) rejection.

Respectfully submitted,

Date: September 28, 2006

William E. Lewis
Attorney for Applicant(s)
Reg. No. 39,274
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-2946